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08/874,781 06/13/97 JOHNSON

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EXAMINER

QM32/0229

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LEWIS, A

ART UNIT

PAPER NUMBER

3761

DATE MAILED:

02/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/874,781

Applicant(s)
BRUCE C. JOHNSON

Examiner
Aaron J. Lewis

Group Art Unit
3761



☒ Responsive to communication(s) filed on Feb 16, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 2-7, 16, 21, and 23-48 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 2, 4-7, 16, 21, 23, 27-31, 39, and 41-44 is/are allowed.

☒ Claim(s) 3, 24-26, 32-34, 36-38, 40, and 45-48 is/are rejected.

☒ Claim(s) 35 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3761

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 02/16/2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/874,781 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 3 recites the limitation "...through an adhesive substance in contact therewith on a surface thereof oriented at least in part the same way as the adhesives face on said first and second end regions to engage the outer wall tissues,..." beginning in 13. Based upon the specific language "...through an adhesive substance in contact therewith...", it is not clear whether applicant intends to claim an adhesive as an element of the claimed combination. If applicant intends to claim the adhesive as an element of the combination, an example of acceptable language would be --a resilient member having an adhesive substance thereon, the resilient member included in at least a portion of the first and second end regions and the intermediate segment which resilient member is capable, at least in part, of resilient deformation that, through the adhesive substance in contact therewith--.

Art Unit: 3761

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3,24,2636,47 are rejected under 35 U.S.C. 102(b) as being anticipated by Iriarte (Spanish patent 289561), for the reasons set forth in the office action dated 10/28/98.

As to claims 3,26,36,47, the body (2) is readable upon the flexible truss and the elastic strip (1) is readable upon the resilient member. The body (2) and elastic strip (1) as illustrated in figs.2,3 include a segment devoid of adhesive and which bridges a patient's nose between opposed ends of the body which adhere to outer wall tissues of a patient's nostrils (fig.2D) which is readable upon an intermediate segment.

As to claim 24, figs. 2A-D and fig.3 of Iriarte illustrate a resilient band (1) oriented substantially parallel to a longitudinal extent of the truss (2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3761

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 32-34,45; 37-38,46; 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iriarte.

As to claims 32,38, Iriarte, page 5, lines 9-14 discloses that portion of the surface of the body (2) which extends beyond the area of the resilient member (1) includes an adhesive for engaging a patient's outer wall tissues. Figs.2A-D and fig.3 illustrate a substantial portion of that side of the body which engages a patient's outer wall tissues and readable upon the intermediate section as discussed above, being covered by resilient member (1); therefore, it would have been obvious that a substantial portion of the intermediate section is not adhesively engaged with a patient's outer wall tissues.

As to claim 33, the resilient member (1) of Iriarte is placed adjacent a first side of the flexible strip of deformable material (2).

As to claims 34,37, while Iriarte discloses a singular resilient member (1), it would have been obvious to replicate the resilient member of Iriarte by mere duplication of an existing structural element. See *In re Harza*, 124 (USPQ) 378 (CCPA 1960); *St. Regis Paper Co., v. Benis Co., Inc.*, 193 USPW 8, 11 (7th Cir. 1977).

As to claims 45,46,48, while Iriarte is silent as to the composition of the material of the truss (1), it is submitted that it would have been obvious to make the truss of Iriarte of any well known material including plastic as an obvious matter of design choice with no new or unobvious results accruing.

Art Unit: 3761

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iriarte as applied to claims 32-34,45; 37-38,46; 48 above and further in view of Shippert ('402).

The difference between Iriarte and claim 25 is first and second release liners covering the adhesive substances on the first and second end regions of the flexible strip material.

Shippert, in an adhesively coated nose splint, teaches first and second release liners covering the adhesive substances on the first and second end regions of the flexible strip material for protecting the adhesive material prior to use.

It would have been obvious to modify the flexible strip of Iriarte to employ any well known means for protecting the adhesive material prior to application to a patient's nose including the use of first and second release liners covering the adhesive substances on any portion of the flexible strip including on the first and second end regions of the flexible strip material because it would have protected the adhesive prior to use as taught by Shippert.

Allowable Subject Matter

9. Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 2,4-7,39; 16,41; 21,42; 23,27,43; 28-31,44 are allowed.

Art Unit: 3761

Response to Arguments

11. Applicant's arguments filed 09/27/99 have been fully considered but they are not persuasive with respect to claims 3,24-26,32-34,36-38,45-48.

Applicant's arguments regarding claim 3 are disagreed with because Iriarte does not disclose an adhesive on the surface of the flexible strip (1) which faces a wearer's skin (on the bridge of the nose) during use. Accordingly, that surface constitutes an adhesive void which bridges a wearer's nose.

Applicant's arguments regarding claims 32,36 and 47 are disagreed with because Iriarte discloses an adhesive between the resilient strip (1) and the body (2) on page 5, lines 9-14. The end surfaces (surfaces which in use are adhered to and located on opposite sides of a wearer's nose) of the body (2) and strip (1) as illustrated in figs.2(a-d) and fig.3 are shown oriented in the same manner. The fact that there is an overlapping portion of body (2) due to its larger relative size does not exemplify end surfaces which are not oriented in the same manner. Further, the limitation "...said resilient member and said flexible strip of material each being in contact with an adhesive at a surface thereof oriented at least in part as are said end surfaces;..." as recited in claim 47 does not distinguish over the prior art in any manner. The strip (1) and body (2) of Iriarte are disclosed and illustrated as being adhesively connected. The body (2) includes an overlapping portion due to its relatively larger size which includes adhesive for adhering the nasal dilator to a patient's nose. The adhesive between the body and flexible strip of Iriarte is illustrated and disclosed to be "oriented" in all directions in which each of the flexible strip and body are.

Art Unit: 3761

Accordingly, Iriarte continues to be prior art which is readable upon claims 32,36,47 for the reasons set forth herein above.

12. Applicant's arguments filed 01/31/2000 have been fully considered but they are not persuasive.

Applicant's arguments regarding claim 3 are noted; however, as explained herein above, the language of claim 3 including the amendments of 01/31/2000 do not make clear whether applicant intends to claim the adhesive as an element in combination with the resilient member. The language of claim 3 currently appears to recite an adhesive as an intended result rather than a positive structural element of the claimed combination.

Applicant's arguments regarding claims 32, 36 and 47 are not persuasive because the adhesive which is recited as being in 'contact with the resilient member at a surface thereof and oriented at least in part as are said end surfaces of the truss', is not defined in any manner which is unobvious over the adhesive which is between the resilient member (1) and body (2) of Iriarte. That is, the adhesive disclosed by Iriarte is oriented at least in part as are the end surfaces of the truss. The placement of an adhesive substance upon the surface of the resilient member which faces a patient's nose and which adheres to a patient's nose in use in addition to an adhesive substance upon the surface of the truss which faces a patient's nose and which adheres to a patient's nose in use has not been defined by the language of these claims. Given the breadth of the language of the

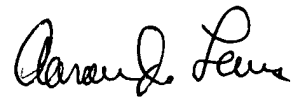
Art Unit: 3761

claims, Iriarte continues to be appropriately applied as prior art in the manner set forth herein above.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Lewis whose telephone number is (703) 308-0716.

Aaron J. Lewis

February 27, 2000



Aaron J. Lewis
Primary Examiner